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EXAMINER	
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ART UNIT	PAPER NUMBER
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/637,138	POVOLNY ET AL.	
	Examiner	Art Unit	
	Mike Tomaszewski	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 November 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *See Continuation Sheet* is/are pending in the application.

4a) Of the above claim(s) *37,38,58,59,78 and 86* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *35,36,39,42,44-47,49-53,55-57,60-64,66-77,79,81-85,87 and 92-101.* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 April 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 35,36,39,42,44-47,49-53,55-57,60-64,66-77,79,81-85,87 and 92-101.

DETAILED ACTION

Notice To Applicant

1. This communication is in response to the application filed on 25 November 2005. Claims 35, 36, 39, 42, 44-47, 49-53, 55-57, 60-64, 66-77, 79, 81-85, 87 and 92-101 are pending. Claims 37, 38, 58, 59, 78 and 86 have been withdrawn. Claims 1-34, 40-41, 43, 48, 54, 65, 80 and 88-91 have been cancelled. Claims 35, 36, 39, 42, 44, 46, 49, 56, 57, 62, 66, 68, 74, 81 and 87 have been amended. Claims 92-101 are newly added.

Specification

2. The Amendment filed 25 November 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. Applicant has failed to provide citations to support the amended and newly added claims.

The newly added material which does not appear to be supported by the original disclosure is as follows:

The recitations of "receiving a data request from a patient via a secure publicly accessible network connection," "the plurality of databases containing medical records data, appointment scheduling data, and billing data pertaining to the patient," and "the

secure publicly accessible network connection" within claims 35; the newly added recitations of "the plurality of databases containing medical records data, appointment scheduling data, and billing data," "the web server adapted to receive data requests from a patient via a secure publicly accessible network connection," and "the secure publicly-accessible network connection" within claim 56; and the newly added recitation "wherein the application server is further adapted to determined the access status without modifying the at least one database" within claim 95.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 35-101 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 35, 56 and 92 recite limitations that are new matter, as discussed above.

Dependent claims 36, 39, 42, 44-47, 49-53, 55, 57, 60-64, 66-77, 79-85, 87, and 93-101 incorporate the deficiencies of independent claims 35, 56, and 95, through dependency, and are also rejected.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 39 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claims 39 and 55 depend from a withdrawn and cancelled claim, respectively, and therefore, are rejected for being indefinite.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

NOTE: The following rejections assume that the subject matter added in the amendment filed on 25 November 2005 is not new matter and are provided hereinbelow for Applicant's consideration on the condition that Applicant properly traverses the new matter objections and rejections set forth in sections 2-5, supra, in the next communication sent in response to the present Office Action.

7. Claims 35-36, 39, 42, 55-57, 60-64, 71-77, 79, 81-85, 87, 92-93, 98-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (5,924,074; hereinafter Evans), in view of Halamka ("Virtual Consolidation of Boston's Beth Israel and New England Deaconess Hospitals via the World Wide Web"; hereinafter Halamka) and in view of Joao (6,283,761; hereinafter Joao).

(A) As per claim 35, Evans discloses a method of collecting and presenting patient data, the method comprising:

(1) receiving a data request via a secure publicly accessible network connection (Evans: abstract; col. 12, line 55-col. 13, line 30; col. 15, lines 11-33; Fig. 1-24);

(2) determining access status (Evans: col. 15, lines 15-35); and

(3) selecting records on the at least one database that satisfy the data request and are accessible (Evans: col. 6, lines 37-47; col. 15, lines 15-35; Fig. 6); and

(4) presenting data from one or more selected data fields on the at least one database in accordance with one or more objects or templates via the secure publicly accessible network connection (Evans: col. 6, lines 6-55).

Evans, however, fails to expressly disclose a method of collecting and presenting patient data, the method comprising:

(5) querying at least one database from a plurality of databases for via a database connectivity module, the plurality of databases containing medical records data, appointment scheduling data, and billing data pertaining to the patient;

(6) receiving a data request from a patient;

(7) determining the access status of the patient;

(8) records are accessible to the patient; and

(9) presenting data to the patient.

Nevertheless, these features are old and well known in the art, as evidenced by Halamka and Joao. In particular, Halamka and Joao disclose

(5) querying at least one database from a plurality of databases for via a database connectivity module (Halamka: pg. 1-5), the plurality of databases containing medical records data, appointment scheduling data, and billing data pertaining to the patient (Joao: abstract; col. 16, line 32-col. 20, line 27; Fig. 1-15B);

(6) receiving a data request from a patient (Joao: abstract; col. 12, lines 51-58; col. 13, line 29-col. 15, line 58; Fig. 1-15B);

(7) determining the access status of the patient (Joao: abstract; col. 4, lines 6-11; col. 7, lines 16-23; Fig. 1-15B);

(8) records are accessible to the patient (Joao: abstract; col. 23, line 60-col. 24, line 11; Fig. 1-15B); and

(9) presenting data to the patient (Joao: abstract; col. 12, lines 51-58; col. 13, line 29-col. 15, line 58; Fig. 1-15B).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Halamka with the combined teachings of Evans and Joao with the motivation of consolidating clinical information from heterogeneous sources (Halamka: pg. 1).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Evans and Halamka with

the motivation of providing a means for processing and providing healthcare and/or healthcare-related information (Joao: col. 7, lines 61-64).

(B) As per claim 36, Evans fails to expressly disclose the method of claim 35, wherein the at least one database includes a legacy database.

Nevertheless, these features are old and well known in the art, as evidenced by Halamka. In particular, Halamka discloses the method of claim 35, wherein the at least one database includes a legacy database (Halamka: pg. 1).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Halamka with the combined teachings of Evans and Joao with the motivation of consolidating clinical information from heterogeneous sources (Halamka: pg. 1).

(C) As per claim 39, Evans fails to expressly disclose the method of claim 38, wherein the data from the at least one database are presented to the patient without modifying the at least one database and without redesigning the at least one database.

Nevertheless, these features are old and well known in the art, as evidenced by Halamka and Joao. In particular, Halamka and Joao disclose the method of claim 38, wherein

(1) the data from the at least one database are presented without modifying the at least one database and without redesigning the at least one database (Halamka: pg. 1-5); and

(2) the data are presented to the patient (Joao: abstract; col. 4, lines 6-11; col. 7, lines 16-23; Fig. 1-15B).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Halamka with the combined teachings of Evans and Joao with the motivation of consolidating clinical information from heterogeneous sources (Halamka: pg. 1).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Evans and Halamka with the motivation of providing a means for processing and providing healthcare and/or healthcare-related information (Joao: col. 7, lines 61-64).

(D) As per claim 42, Evans discloses the method of claim 35, wherein the step of presenting the data comprises presenting the selected data fields with one or more objects or templates in a form chosen from the group consisting of clinical records, digital images, treatment records, diagnoses, treatment plans, educational information regarding treatment, appointments, recalls, bills, patient payments and charges, insurance payments and charges, no shows, greetings, prescriptions, referrals, and referral reports (Evans: abstract; Fig. 1-24).

Evans, however, fails to expressly disclose the method of claim 35, wherein data is presented to the patient.

Nevertheless, these features are old and well known in the art, as evidenced by Joao. In particular, Joao discloses the method of claim 35, wherein data is presented to the patient (Joao: abstract; col. 4, lines 6-11; col. 7, lines 16-23; Fig. 1-15B).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Evans and Halamka with the motivation of providing a means for processing and providing healthcare and/or healthcare-related information (Joao: col. 7, lines 61-64).

(E) As per claim 55, Evans discloses the method of claim 54, wherein the at least one database is not designed for presenting data to the recipient from one or more selected data fields on the at least one database in accordance with one or more objects or templates via a medium determined by the recipient (Evans: abstract; col. 6, lines 6-55; col. 15, lines 15-35; Fig. 1-24).

(F) Claim 56 substantially repeats the same limitations as those in claim 35 and is therefore, rejected for the same reasons given for claim 35 and incorporated herein.

(G) Claims 57 and 60 substantially repeat the same limitations as those in claims 36 and 39, respectively, and therefore, are rejected for the same reasons given for those claims and incorporated herein.

(H) As per claim 61, Evans fails to expressly disclose the system of claim 56, wherein the database connectivity module can connect to a plurality of heterogeneous, cross-platform databases.

Nevertheless, these features are old and well known in the art, as evidenced by Halamka. In particular, Halamka discloses the system of claim 56, wherein the database connectivity module can connect to a plurality of heterogeneous, cross-platform databases (Halamka: pg. 1-5).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Halamka with the combined teachings of Evans and Joao with the motivation of consolidating clinical information from heterogeneous sources (Halamka: pg. 1).

(I) As per claim 62, Evans fails to expressly disclose the system of claim 61, wherein the heterogeneous, cross-platform data bases comprise a plurality of databases having a plurality of database infrastructure constraints and a plurality of software constraints.

Nevertheless, these features are old and well known in the art, as evidenced by Halamka. In particular, Halamka discloses the system of claim 61, wherein the heterogeneous, cross-platform data bases comprise a plurality of databases having a plurality of database infrastructure constraints and a plurality of software constraints (Halamka: pg. 1-5).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Halamka with the combined teachings of Evans and Joao with the motivation of consolidating clinical information from heterogeneous sources (Halamka: pg. 1).

(J) As per claim 63, Evans discloses the system of claim 56, wherein the system is configured to receive requests for patient data over a web browser through the web server (Evans: abstract; col. 12, line 54-col. 13, line 30; Fig. 1-24).

(K) As per claim 64, Evans discloses the system of claim 63, wherein the system is configured to deliver data through the web server on the web browser (Evans: abstract; col. 12, line 54-col. 13, line 30; Fig. 1-24).

(L) As per claim 71, Evans fails to expressly disclose the system of claim 56, wherein the database connectivity module comprises an Open DataBase Connectivity (ODBC) module.

Nevertheless, this feature is old and well known in the art, as evidenced by Halamka. In particular, Halamka discloses the system of claim 56, wherein the database connectivity module comprises an Open DataBase Connectivity (ODBC) module (Halamka: pg. 1-5).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Halamka with the combined teachings of Evans and Joao with

the motivation of consolidating clinical information from heterogeneous sources (Halamka: pg. 1).

(M) As per claim 72, Evans fails to expressly disclose the system of claim 56, wherein the at least one database is a provider database and wherein the database connectivity module comprises tools and applications to access the provider database and to take data from the provider database.

Nevertheless, this feature is old and well known in the art, as evidenced by Halamka. In particular, Halamka discloses the system of claim56, wherein the at least one database is a provider database and wherein the database connectivity module comprises tools and applications to access the provider database and to take data from the provider database (Halamka: pg. 1-5).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Halamka with the combined teachings of Evans and Joao with the motivation of consolidating clinical information from heterogeneous sources (Halamka: pg. 1).

(O) As per claim 73, Evans fails to expressly disclose the system of claim 72, wherein the provider database is a proprietary database having an undocumented interface.

Nevertheless, this feature is old and well known in the art, as evidenced by Halamka. In particular, Halamka discloses the system of claim 72, wherein the provider

database is a proprietary database having an undocumented interface (Halamka: pg. 1-5).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Halamka with the combined teachings of Evans and Joao with the motivation of consolidating clinical information from heterogeneous sources (Halamka: pg. 1).

(P) As per claim 74, Evans fails to expressly disclose the system of claim 56, wherein the system is further controlled and configured to collecting patient data.

Nevertheless, this feature is old and well known in the art, as evidenced by Joao. In particular, Joao discloses the system of claim 56, wherein the system is further controlled and configured to collecting patient data (Joao: abstract; col. 8, lines 27-34; Fig. 1-15B).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Evans and Halamka with the motivation of providing a means for processing and providing healthcare and/or healthcare-related information (Joao: col. 7, lines 61-64).

(Q) As per claim 75, Evans discloses the system of claim 74, wherein the patient data comprises patient histories, questions for the practitioner, and e-mail addresses, wherein the patient data is collected without burdening a practitioner, and wherein the

system is configured to receive the patient data over a designated terminal within an office of the practitioner (Evans: abstract; Fig. 1-15B).

(Q) As per claim 76, Evans fails to expressly disclose the system of claim 75, wherein the system is configured to automatically send customized correspondence to the patient based on the patient data.

Nevertheless, this feature is old and well known in the art, as evidenced by Joao. In particular, Joao discloses the system of claim 75, wherein the system is configured to automatically send customized correspondence to the patient based on the patient data (Joao: abstract; col. 5, lines 7-18; Fig. 1-15B).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Evans and Halamka with the motivation of providing a means for processing and providing healthcare and/or healthcare-related information (Joao: col. 7, lines 61-64).

(R) Per the previous Office Action, Examiner has taken Official Notice that the limitations recited in claims 75-77, 79, 81-85, and 87 are old and well known in the art.

(S) As per newly added claim 92, Evans discloses a system for collecting and presenting patient data (Evans: abstract), the system comprising:

(1) a server adapted to:

(a) determine access status (Evans: col. 15, lines 15-35).

Evans, however fails to expressly disclose the a system for collecting and presenting patient data, the system comprising:

(2) a web server adapted to send and receive information to/from a patient via a secure publicly accessible network connection;

(3) a database server adapted to communicate with a plurality of databases containing medical records data, appointment scheduling data, and billing data; and

(4) an application server operatively coupled to the web server and the database server, the application server adapted to:

(b) submit a query to at least one database via the database server based on an information request received from the patient via the web server;

(c) provide patient access;

(d) receive data records from the at least one database that satisfy the query and are permitted to be accessed by the patient; and

(e) present responsive information to the patient via the web server, the responsive information being selected from the data records and formatted in accordance with one or more objects or templates.

Nevertheless, these features are old and well known in the art, as evidenced by Halamka and Joao. In particular, Halamka and Joao disclose the a system for collecting and presenting patient data, the system comprising:

(2) a web server adapted to send and receive information to/from a patient via a secure publicly accessible network connection (Joao: abstract; col. 12, lines 51-58; col. 13, line 29-col. 15, line 58; Fig. 1-15B);

(3) a database server adapted to communicate with a plurality of databases containing medical records data, appointment scheduling data, and billing data (Joao: abstract; col. 16, line 32-col. 20, line 27; Fig. 1-15B); and

(4) an application server operatively coupled to the web server and the database server (Joao: abstract; col. 2, line 64-col. 4, line 26; Fig. 1-15B), the application server adapted to:

(b) submit a query to at least one database via the database server based on an information request received from the patient (Joao: abstract; col. 23, line 60-col. 24, line 12; Fig. 1-15B; Examiner notes that Joao's system may be used by patients, among others.) via the web server (Halamka: abstract and pg. 1);

(c) provide patient access (Joao: abstract; col. 23, line 60-col. 24, line 12; Fig. 1-15B; Examiner notes that Joao's system may be used by patients, among others.);

(d) receive data records from the at least one database that satisfy the query and are permitted to be accessed by the patient (Joao: abstract; col. 12, lines 51-58; col. 13, line 29-col. 15, line 58; Fig. 1-15B); and

(e) present responsive information to the patient via the web server, the responsive information being selected from the data records and formatted in accordance with one or more objects or templates (Joao: abstract; col. 12, lines 51-58; col. 13, line 29-col. 15, line 58; Fig. 1-15B).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Halamka with the combined teachings of Evans and Joao with the motivation of consolidating clinical information from heterogeneous sources (Halamka: pg. 1).

Moreover, one of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Evans and Halamka with the motivation of providing a means for processing and providing healthcare and/or healthcare-related information (Joao: col. 7, lines 61-64).

(T) Newly added claim 93 substantially repeats the same limitations as claim 36 and therefore, is rejected for the same reasons given for claim 36 above and incorporated herein.

(U) As per newly added claim 98, Evans fails to expressly disclose the system of claim 97, wherein the patient data comprises at least one of patient health history, questions for a practitioner, and e-mail address.

Nevertheless, these features are old and well known in the art, as evidenced by Joao. In particular, Joao discloses the system of claim 97, wherein the patient data comprises at least one of patient health history, questions for a practitioner, and e-mail address (Joao: abstract; col. 16, lines 33-65; col. 19, lines 54-64).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Evans and Halamka with the motivation of providing a means for processing and providing healthcare and/or healthcare-related information (Joao: col. 7, lines 61-64).

(V) As per newly added claim 99, Evans fails to expressly disclose the system of claim 92, wherein the application server is further adapted to send customized correspondence to the patient via the web server.

Nevertheless, these features are old and well known in the art, as evidenced by Joao. In particular, Joao discloses the system of claim 92, wherein the application server is further adapted to send customized correspondence to the patient via the web server (Joao: abstract; col. 5, lines 7-19; Fig. 1-15B).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Evans and Halamka with

the motivation of providing a means for processing and providing healthcare and/or healthcare-related information (Joao: col. 7, lines 61-64).

(W) As per newly added claim 100, Evans fails to expressly disclose the system of claim 99, wherein the customized correspondence includes at least one of billing reminders, appointment reminders, recall reminders, and no show reminders.

Nevertheless, these features are old and well known in the art, as evidenced by Joao. In particular, Joao discloses the system of claim 99, wherein the customized correspondence includes appointment reminders (Joao: abstract; col. 5, lines 7-19; col. 33, lines 15-25; Fig. 1-15B).

The Examiner has noted insofar as claim 100 recites "at least one of billing reminders, appointment reminders, recall reminders, and no show reminders," appointment reminders is recited.

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Evans and Halamka with the motivation of providing a means for processing and providing healthcare and/or healthcare-related information (Joao: col. 7, lines 61-64).

(X) As per newly added claim 101, Evans fails to expressly disclose the system of claim 92, wherein the application server is further adapted to receive appointment requests from the patient via the web server.

Nevertheless, these features are old and well known in the art, as evidenced by Joao. In particular, Joao discloses the system of claim 92, wherein the application server is further adapted to receive appointment requests from the patient via the web server (Joao: abstract; col. 5, lines 7-19; col. 31, line 65-col. 33, line col. 33, lines 25; Fig. 1-15B).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Evans and Halamka with the motivation of providing a means for processing and providing healthcare and/or healthcare-related information (Joao: col. 7, lines 61-64).

7. Claims 44-47, 49, 66-70, 94-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans, Halamka and Joao as applied to claims 35, 56 and 92 above, and further in view of Bessette (6,263,330; hereinafter Bessette).

(A) As per claim 44, Evans discloses the method of claim 35, wherein the step of determining access status comprises matching an identifier and a password to values thereof stored in a password repository (Evans: abstract; col. 14, lines 42-50; col. 15, lines 15-35).

Evans, however, fails to expressly disclose the method of claim 35, wherein access status of a patient is determined and wherein the password repository is not associated with the at least one database.

Nevertheless, these features are old and well known in the art, as evidenced by Joao and Bessette. In particular, Joao and Bessette disclose the method of claim 35, wherein:

(1) access status of a patient is determined (); and

(2) wherein the password repository is not associated with the at least one database (Bessette: abstract; col. 7, lines 4-12; col. 10, lines 6-18).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Evans, Halamka and Bessette with the motivation of providing a means for processing and providing healthcare and/or healthcare-related information (Joao: col. 7, lines 61-64).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Bessette with the combined teachings of Evans, Joao and Halamka with the motivation of increasing system speed and efficiency (Bessette: col. 10, lines 9-16).

(B) As per claim 45, Evans fails to expressly disclose the method of claim 44, wherein the access status is determined without modifying the at least one database.

Nevertheless, these features are old and well known in the art, as evidenced by Bessette. In particular, Bessette discloses the method of claim 44, wherein the access status is determined without modifying the at least one database (Bessette: abstract; col. 7, lines 4-12; col. 10, lines 6-18).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Bessette with the combined teachings of Evans, Joao and Halamka with the motivation of increasing system speed and efficiency (Bessette: col. 10, lines 9-16).

(C) As per claim 46, Evans fails to expressly disclose the method of claim 44, wherein the patient further supplies elements of data in response to queries, which elements are matched against the at least one database entries to grant or deny access and wherein the matching of the elements against the database entries is integrated with, but managed separately from, the at least one database.

Nevertheless, these features are old and well known in the art, as evidenced by Bessette. In particular, Bessette discloses the method of claim 44, wherein the patient further supplies elements of data in response to queries, which elements are matched against the at least one database entries to grant or deny access and wherein the matching of the elements against the database entries is integrated with, but managed separately from, the at least one database (Bessette: abstract; col. 7, lines 4-12; col. 10, lines 6-18).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Bessette with the combined teachings of Evans, Joao and Halamka with the motivation of increasing system speed and efficiency (Bessette: col. 10, lines 9-16).

(D) As per claim 47, Evans fails to expressly disclose the method of claim 46, wherein the patient is able to issue and maintain its access status without any assistance from a practitioner.

Nevertheless, these features are old and well known in the art, as evidenced by Bessette. In particular, Bessette discloses the method of claim 46, wherein the patient is able to issue and maintain its access status without any assistance from a practitioner (Bessette: abstract; col. 7, lines 4-12; col. 10, lines 6-18).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Bessette with the combined teachings of Evans, Joao and Halamka with the motivation of increasing system speed and efficiency (Bessette: col. 10, lines 9-16).

(E) As per claim 49, Evans fails to expressly disclose the method of claim 46, wherein the elements matched against database entries include one or more of birthdate, social security number, and other identifying information, and wherein the step of determining access status of the patient further comprises prompting the patient for additional data until an authenticated, unambiguous match is established.

Nevertheless, these features are old and well known in the art, as evidenced by Joao and Bessette. In particular, Joao and Bessette disclose the method of claim 46, wherein:

(1) the elements matched against database entries include one or more of birthdate, social security number, and other identifying information, and

wherein the step of determining access status further comprises prompting the patient for additional data until an authenticated, unambiguous match is established (Bessette: abstract; col. 7, lines 4-12; col. 10, lines 6-18);

(2) determining access status of the patient (Joao: abstract; col. 4, lines 6-11; col. 7, lines 16-23; Fig. 1-15B); and

(3) prompting the patient for additional data (Joao: abstract; col. 4, lines 6-11; col. 7, lines 16-23; Fig. 1-15B).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Evans, Halamka and Bessette with the motivation of providing a means for processing and providing healthcare and/or healthcare-related information (Joao: col. 7, lines 61-64).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Bessette with the combined teachings of Evans, Joao and Halamka with the motivation of increasing system speed and efficiency (Bessette: col. 10, lines 9-16).

(F) Claim 66 has been amended to substantially repeat the same limitations as those of claim 44 and therefore, is rejected for the same reasons given for claim 44 and incorporated herein.

(G) Claim 67 substantially repeats the same limitations as those of claim 45 and therefore, is rejected for the same reasons given for claim 45 and incorporated herein.

(H) Claim 68 has been amended to substantially repeat the same limitations as those of claim 46 and therefore, is rejected for the same reasons given for claim 46 and incorporated herein.

(I) As per claim 69, Evans fails to expressly disclose the system of claim 68, wherein the system is configured to manage the matching of the elements against the database entries away from the at least one database.

Nevertheless, these features are old and well known in the art, as evidenced by Bessette. In particular, Bessette discloses the system of claim 68, wherein the system is configured to manage the matching of the elements against the database entries away from the at least one database (Bessette: abstract; col. 7, lines 4-12; col. 10, lines 6-18).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Bessette with the combined teachings of Evans, Joao and Halamka with the motivation of increasing system speed and efficiency (Bessette: col. 10, lines 9-16).

(J) As per claim 70, Evans fails to expressly disclose the system of claim 68, wherein the elements matched against database entries include one or more of

birthdate, social security number, and identifying information, and wherein the system is configured to prompt the user for additional data until an authenticated, unambiguous match is established.

Nevertheless, these features are old and well known in the art, as evidenced by Bessette. In particular, Bessette discloses the system of claim 68, wherein the elements matched against database entries include one or more of birthdate, social security number, and identifying information, and wherein the system is configured to prompt the user for additional data until an authenticated, unambiguous match is established (Bessette: abstract; col. 7, lines 4-12; col. 10, lines 6-18).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Bessette with the combined teachings of Evans, Joao and Halamka with the motivation of increasing system speed and efficiency (Bessette: col. 10, lines 9-16).

(K) Newly added claim 94 substantially repeats the same limitations as claim 44 and therefore, is rejected for the same reasons given for claim 44 above and incorporated herein.

(L) Newly added claim 95 substantially repeats the same limitations as claim 45 and therefore, is rejected for the same reasons given for claim 45 above and incorporated herein.

(M) Newly added claim 96 substantially repeats the same limitations as claims 46-47 and therefore, is rejected for the same reasons given for claims 46-47 above and incorporated herein.

(N) Newly added claim 97 substantially repeats the same limitations as claim 49 and therefore, is rejected for the same reasons given for claim 49 above and incorporated herein.

8. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Evans, Halamka, and Joao as applied to claims 35, 56 and 92 above, and further in view of Ralston (6,389,454; hereinafter Ralston).

(A) As per claim 50, Evans discloses the method of claim 35, wherein data within the at least one database includes:

(1) a schedule of appointments (Evans: col. 5, line 55-col. 6, line 10).

Evans, however, fails to expressly disclose the method of claim 35, wherein data within the at least one database includes:

(2) an array of blocks of time set aside for specific procedures, each of the procedures having a unique scheduling code;

(3) an array of patients requiring a procedure, each of the procedures having a scheduling codes as specified in (1); and

(4) wherein a patient requiring a procedure schedules a block of time for the procedure by selecting a block of time having a scheduling code corresponding to the patient's scheduling code.

Nevertheless, these features are old and well known in the art, as evidenced by Ralston. In particular, Ralston discloses the method of claim 35, wherein data within the at least one database includes:

(2) an array of blocks of time set aside for specific procedures, each of the procedures having a unique scheduling code (Ralston: col. 5, lines 55-60);

(3) an array of patients requiring a procedure, each of the procedures having a scheduling codes as specified in (1) (Ralston: col. 2, lines 55-64; col. 5, lines 50-60); and

(4) wherein a patient requiring a procedure schedules a block of time for the procedure by selecting a block of time having a scheduling code corresponding to the patient's scheduling code (Ralston: col. 5, lines 50-66).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Ralston with the combined teachings of Evans, Joao and Halamka with the motivation of ease of scheduling appointments (Ralston: col. 2, lines 50-55).

9. Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Evans, Halamka and Joao as applied to claims 35, 56 and 92 above, and further in view of Cummings, Jr. (5,301,105; hereinafter Cummings).

(A) As per claim 51, Evans discloses the method of claim 35, further comprising:

(1) billing and payment records (Evans: col. 1, lines 28-30).

Evans, however, fails to expressly disclose the method of claim 35, further comprising:

(2) receiving payment for a health care provider on behalf of a patient;

(3) posting payment information into patient accounts on the at least one database;

(4) tracking copayments and deductibles for the patient on the databases; and

(5) billing copayment and deductible balances to the patient with an explanation of copayments and deductibles to the patient.

Nevertheless, these features are old and well known in the art, as evidenced by Cummings. In particular, Cummings discloses the method of claim 35, further comprising:

(1) receiving payment for a health care provider on behalf of a patient (Cummings: abstract; col. 12, lines 22-32; col. 18, lines 32-35);

(2) posting payment information into patient accounts on the at least one database (Cummings: abstract; col. 12, lines 22-32; col. 18, lines 32-35);

(3) tracking copayments and deductibles for the patient on the databases (Cummings: abstract; col. 12, lines 22-32; col. 18, lines 32-35); and

(4) billing copayment and deductible balances to the patient with an explanation of copayments and deductibles to the patient (Cummings: abstract; col. 12, lines 22-32; col. 18, lines 32-35).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Cummings with the combined teachings of Evans, Joao and Halamka with the motivation of providing patients with complete and comprehensive health care and payment (Cummings: col. 1, lines 59-60).

10. Claims 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans, Halamka, Joao, and Cummings as applied to claim 51 above, and further in view of Sackler (5,235,507; hereinafter Sackler).

(A) As per claim 52, Evans fails to expressly disclose the method of claim 51, wherein the step of tracking copayments and deductibles for the patient comprises grouping and aggregating deductibles and copayments by patient families.

Nevertheless, these features are old and well known in the art, as evidenced by Sackler. In particular, Sackler discloses the method of claim 51, wherein the step of tracking copayments and deductibles for the patient comprises grouping and aggregating deductibles and copayments by patient families (Sackler: col. 2, lines 10-57; col. 3, lines 20-27).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Sackler with the combined teachings of Evans, Joao, Halamka and Cummings with the motivation of handling claims for services more efficiently (Sackler: col. 1, lines 43-44).

(B) As per claim 53, Evans fails to expressly disclose the method of claim 52, further comprising reporting deductibles and copayments grouped and aggregated by patient families to a family member.

Nevertheless, these features are old and well known in the art, as evidenced by Sackler. In particular, Sackler discloses the method of claim 52, further comprising reporting deductibles and copayments grouped and aggregated by patient families to a family member (Sackler: col. 2, lines 10-57; col. 3, lines 20-27).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Sackler with the combined teachings of Evans, Joao, Halamka and Cummings with the motivation of handling claims for services more efficiently (Sackler: col. 1, lines 43-44).

Response to Arguments

11. Applicant's arguments with respect to claims 35, 36, 39, 42, 44-47, 49-53, 55-57, 60-64, 66-77, 79, 81-85, and 87-101 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's remaining arguments have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 25 November 2005.

(A) On page 15 of the 25 November 2005 response, Applicant states claims 48 and 59 remain in this application. Examiner notes, however, that Applicant has identified claim 48 as cancelled on page 4 of the 25 November 2005 response and claim 59 as withdrawn on page 8 of the 25 November 2005 response.

(B) On page 17 of the 25 November 2005 response, Applicant argues that no attempt was made to show any teaching or suggestion to combine the Evans and Halamka references.

In response, Examiner respectfully submits that Examiner has indeed provided a teaching or suggestion to combine the Evans and Halamka references. The teaching or suggestion to combine the Evans and Halamka references was the motivation of consolidating clinical information from heterogeneous sources (Halamka: pg. 1).

(C) On page 18 of the 25 November 2005 response, Applicant again argues that no attempt was made to show any teaching or suggestion to combine the references applied.

In response, Examiner respectfully submits that Examiner has indeed provided a teaching or suggestion to combine every reference applied including Evans, Halamka, Bessette, Ralston, Cummings, Sackler and Joao (See previous Office Action and the current Office Action for teaching or suggestion (i.e., motivations to combine)).

(D) On page 21 of the 25 November 2005 response, Applicant requests support for the Examiner having taken official notice "that it was well known in the electronic medical arts to send customized messages to patients based on their conditions or personal data." Per Applicant's request for evidence, Examiner directs Applicant's attention to Joao.

Affidavit

13. Although the declaration of Frith Maier under 37 C.F.R. § 1.132 are moot in view of the new ground(s) of rejection, it was carefully considered and would have been deemed to be insufficient and unpersuasive to overcome the rejections of the prior and current Office Action, if they had been maintained, for the following reasons:

(A) Examiner notes that in assessing the weight to be given expert testimony, the examiner may properly consider, *inter alia*, the following:

(1) The interest of the expert in the outcome of the case. For example, the fact that affiant is not independent of the inventor or the assignee is relevant to the weight to be given to the affidavit. *Cf. Redac Int'l, Ltd. V. Lotus Development Corp.*, 81 F.3d 1576, 38 USPQ2d 1665 (Fed. Cir. 1996) (holding that applicant committed inequitable conduct when applicant withheld information on significant prior connections with the

author of the affidavit – the prior connection was considered material to patentability of the claims.). *See also, Pargon Podiatry Lab., Inc. v. KLM Lab., Inc.*, 948 F.2d 1182, 1191, 25 USPQ2d 1561, 1568 (Fed. Cir. 1993); and

(2) An inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention. *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996). See MPEP § 716.

As such, Examiner notes that Mr. Frith Maier is one of the named inventors in the current application and the President of Sesame Communications, the assignee of the current application (Maier: decl. ¶ 3), and therefore, the weight of the declaration is assessed accordingly.

(B) Examiner notes further that in considering evidence of commercial success and long felt need, evidence should persuasively demonstrate that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the

invention are entitled to little weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CPA 1973). See MPEP §§ 716.03 and 716.04.

In the present case, as noted above, there is no clear nexus between the claimed invention and the averred statements. Note, for example, the "central repository" and "linking disparate data" of Mr. Maier's affidavit—¶ 6 is not present in all claims.

Secondly, it is not clear whether the commercial success was the result of heavy advertising or usage by purchasers normally tied to applicant or assignee.

Thirdly, the "sales figures" of ¶ 8 are not adequately defined—time periods product was marketed and sold; what sales are "normally" expected in the market, etc.

Establishing long-felt need, on the other hand, requires objective evidence that an art recognized problem existed in the art for a long period of time without solution. The relevance of long-felt need and the failure of others to the issue of obviousness depends on several factors.

First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967) ("Since the alleged problem in this case was first recognized by appellants, and others apparently have not yet become aware of its existence, it goes without saying that there could not possibly be any evidence of either a long felt need in the . . . art for a solution to a problem of dubious existence or failure of others skilled in the art who unsuccessfully attempted to solve a problem of which they were not aware."); *Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 217 USPQ 1281 (Fed. Cir. 1983) (Although the claimed invention achieved the

desirable result of reducing inventories, there was no evidence of any prior unsuccessful attempts to do so.).

Second, the long-felt need must not have been satisfied by another before the invention by applicant. *Newell Companies v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988) (Although at one time there was a long-felt need for a "do-it-yourself" window shade material which was adjustable without the use of tools, a prior art product fulfilled the need by using a scored plastic material which could be torn. "[O]nce another supplied the key element, there was no long-felt need or, indeed, a problem to be solved".)

Third, the invention must in fact satisfy the long-felt need. *In re Cavanagh*, 436 F.2d 491, 168 USPQ 466 (CCPA 1971).

For further guidance, see MPEP § 716.04

(C) Examiner also notes that alleged copying is not persuasive of nonobviousness when the copy is not identical to the claimed product, and the other manufacturer had not expended great effort to develop its own solution. *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985). See also *Vandenberg v. Dairy Equipment Co.*, 740 F.2d 1560, 1568, 224 USPQ 195, 199 (Fed. Cir. 1984) (evidence of copying not found persuasive of nonobviousness). See MPEP § 716.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied art teaches an electronic provider-patient interface system (6,757,898); a computer-based patient recording system (6,792,574); an individualized patient electronic medical records system (6,523,009); an electronic clinical recording system (6,272,470); and a computer system and method for storing medical histories using a carrying size card (5,659,741).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MT

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